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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,370	10/10/2002	David L. Newton	IN-5582	1005
26922	7590	03/18/2004		
BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442			EXAMINER THEXTON, MATTHEW	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,370

Applicant(s)

NEWTON, DAVID L.

Examiner

Matthew A. Thexton

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CV

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to a two-component corrosion inhibiting coating composition, classified in class 252, subclass 389.22 et al.
 - II. Claim 18, drawn to a method of coating a substrate, classified in class 427, subclass 409.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process: a single-layer rather than a multi-layer coating process.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation between William P. Fletcher and Anne Gerry Sabourin (Reg. No. 33,772) on 2/20/2004 a provisional election was made *with* traverse to prosecute the invention of group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action.

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5. Claim 18 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The use of the trademarks HEUCORIN ®, IRGACOR ®, R-M ®, DIAMONT ®, and BORCHI ® has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology. See paragraphs 0013, 0045, 0073-0075.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The disclosure is objected to because of the following informalities:

Example 1 refers to compositions (A), (B), and (C). The accompanying table has three columns for amounts, but they are not labeled. Only the last column contains either compound (I) or (II), contrary to the text accompanying. The table lists "ZCPP/SRPP" but there is no explanation of this component. The results set forth in Example 2 cannot be understood without clearly describing compositions (A), (B), and (C).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-10, 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 describes a second compound (II). It is identified as "one or more carboxy phosphate esters" and then a chemical formula and definitions for the substituents are set forth. The specification identifies LUBRIZOL ® 2063 as falling within the claim. Information from the Lubrizol Corporation website describe the product as having both hydroxy and carboxy functionality. The term "carboxy" appears to imply carboxylic acid functional groups are present. However, the chemical formula and definitions for substituents do not comport with the identifying phrase "one or more carboxy phosphate esters." The only instances in which "carboxy" are within the substituents description is when R is C6 to C10 aromatic hydrocarbon group that is substituted with one or more -COOR' groups.

The definitions for the substituents state that "x" may be 0 to 3. This is not consistent with the identifying phrase "one or more carboxy phosphate esters" because if "x" is zero then the material is not a "carboxy" compound.

The conflicting descriptions suggests that applicant was not in possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-10, 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 describes a second compound (II). It is identified as "one or more carboxy phosphate esters" and then a chemical formula and definitions for the substituents are set forth. The specification identifies LUBRIZOL ® 2063 as falling within the claim. Information from the Lubrizol Corporation website describe the product as having both hydroxy and carboxy functionality. The term "carboxy" appears to imply carboxylic acid functional groups are present. However, the chemical formula and definitions for substituents do not comport with the identifying phrase "one or more carboxy phosphate esters." The only instances in which "carboxy" are within the substituents description is when R is C6 to C10 aromatic hydrocarbon group that is substituted with one or more -COOR' groups.

The definitions for the substituents state that "x" may be 0 to 3. This is not consistent with the identifying phrase "one or more carboxy phosphate esters" because if "x" is zero then the material is not a "carboxy" compound.

The conflicting descriptions place an undue burden of undue experimentation upon the public to determine what are the metes and bounds of the claims.

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Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim employs the verb "demonstrates" but does not set forth any object that could be understood to be something demonstrated. The claim is not understood.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim refers to a comparison, however, the statement is inchoate. The claim does not identify the coating to be compared. The claim is not understood.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-15 of copending Application No. 10429141 in view of product data sheet for IRGACOR ® 153.

The claims 11-15 appear to encompass the same subject matter as the present claims with the exception of not requiring a corrosion inhibitor. The product data sheet for IRGACOR ® 153 suggests it be added to various solvent based formulations including 2 pack epoxy systems, epoxy esters and alkyds, acrylic resins, and 2 pack polyurethane primers. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the noted corrosion inhibitor in order to obtain the benefits indicated in the product data sheet, and thus to arrive at the formulations claimed.

This is a provisional obviousness-type double patenting rejection.

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6599965 (Lane et al.) in view of product data sheet for IRGACOR ® 153.

The claim 8 appears to encompass the same subject matter as the present claims with the exception of not requiring a corrosion inhibitor. The product data sheet for IRGACOR ® 153 suggests it be added to various solvent based formulations including 2 pack epoxy systems, epoxy esters and alkyds, acrylic resins, and 2 pack polyurethane primers. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the noted corrosion inhibitor in order to obtain the

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benefits indicated in the product data sheet, and thus to arrive at the formulations claimed.

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, and 6 of U.S. Patent No. 6534121 (Newton et al.) in view of product data sheet for IRGACOR ® 153.

The claims 1,2,5, and 6 appear to encompass the same subject matter as the present claims with the exception of not requiring a corrosion inhibitor, and with the distinction of being directed to a method of coating. The method of coating necessarily requires the formulations employed. The product data sheet for IRGACOR ® 153 suggests it be added to various solvent based formulations including 2 pack epoxy systems, epoxy esters and alkyds, acrylic resins, and 2 pack polyurethane primers. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the noted corrosion inhibitor in order to obtain the benefits indicated in the product data sheet, and thus to arrive at the formulations claimed.

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-15 of U.S. Patent No. 6458874 (Newton) in view of product data sheet for IRGACOR ® 153.

The claims 11-15 appear to encompass the same subject matter as the present claims with the exception of not requiring a corrosion inhibitor. The product data sheet for IRGACOR ® 153 suggests it be added to various solvent based formulations

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including 2 pack epoxy systems, epoxy esters and alkyds, acrylic resins, and 2 pack polyurethane primers. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the noted corrosion inhibitor in order to obtain the benefits indicated in the product data sheet, and thus to arrive at the formulations claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jedlicka (US 3415766) and product data sheet for IRGACOR® 153.

The Jedlicka reference ('766) discloses coating formulations comprising resin forming and cross-linking components (column 10, line 54 through column 11, line 14) and organic phosphate component formed from polyhydroxy reactants and polycarboxy reactants and phosphoric acid (column 3, line 45 through column 4, line 21). The reference further suggests corrosion inhibitors, however these are different from the inhibitors required by the present claims (column 11, lines 58-64). The present claims are directed to formulations having two types of organic phosphate esters; combinations are not disclosed in the reference.

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The product data sheet for IRGACOR ® 153 suggests it be added to various solvent based formulations including 2 pack epoxy systems, epoxy esters and alkyls, acrylic resins, and 2 pack polyurethane primers. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the noted corrosion inhibitor in order to obtain the benefits indicated in the product data sheet, and thus to arrive at formulations containing this corrosion inhibitor.

Absent a showing of unexpected results, it would have been obvious to one of ordinary skill in the art to employ commercially available organic phosphate esters such as LUBRIZOL ® 2063 and BORCHI ® Gen HMP in view of the broad teaching of their utility in '766; and to employ them in combination in the formulation is obvious since they are indicated to have the same utility.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Temple et al. (5859154) discloses organic phosphate esters in coating formulations comprising resin forming component and crosslinking agent. The organic phosphate esters are different from those encompassed by the present claims based on the properties set forth (column 3, lines 40-47).

Higgins et al. (4436855) discloses two-part coating formulations having corrosion inhibiting property and comprising acidic esters of phosphoric acids which are formed from hydroxy and polyhydroxy organic compounds reacted with phosphorus-containing

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reactant. The resulting phosphoric esters do not appear to be the same as either components (I) or (II) of the present claims.

Behmel et al. (US 4450257) discloses formulations comprising resins with organic polyphosphoric esters with improved adhesion and corrosion protection of metal substrates. The polyphosphoric acid distinguishes this reference from the claims.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 571-272-1125. The examiner can normally be reached on Monday-Friday, 9:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. A. Thexton

Matthew A. Thexton
Primary Examiner
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